

REMARKS—General**Article II.**

After this amendment, **claims 33-37 and 39-53** will be pending. **Claim 53** is new. **Claim 38** has been cancelled.

Summary of changes to claims

1. In the office action of 3-15-2006, the examiner states: "... claims 33-52 in view of the above cited MPEP section [101], are not statutory because they merely recite a number of computing steps without producing any tangible result and/or being limited to a practical application within the technological arts. All the recited steps of the method in claims 33, 39 and 43 do not produce concrete and assured repeatable result. Their dependents are rejected under the same reason as to their independent claims."

- (a) In the Lundgren decision (Appeal No. 2003-2088) it was decided that there is no judicially recognized separate "technological arts" test to determine patent eligible subject matter under 101.
 - (b) The present invention is in the same technological area as Bugajski (No. 5,592,667) (1997), which was statutory under 101.
 - (c) The present invention is in class 707 (Data processing: Database and file management or data structures), subclass 101 (Manipulating data structure (e.g. compression, compaction, compilation)), which is statutory. The present invention is a method for performing data compression.
2. The examiner states "Claims 38-53 are rejected under 35 U.S.C. 112, second paragraph, as being indefinite for failing to particularly point out and distinctly claim the subject matter which applicant regards as the invention."
- (a) In **claims 33, 39, and 43**, the following changes were made to the description of the problem space:
 - 1. "is capable of" has been replaced with more definite language, (although:
 - a. Over 21,000 patents have been issued since 1974 that have the phrase "capable of" in the claims, and
 - b. The phrase "capable of" has been approved of as a claim element in *Hayes Microcomputer Products, Inc. Patent Litigation*, 982 F.2d 1527, 1534-35, 25 USPQ2d 1241, 1246 (Fed. Cir. 1992)("One skilled in the art would know how to program a microprocessor to perform the necessary steps described in the

specification. Thus an inventor is not required to describe every detail of his invention").

2. The limitation of claim 38 has been added.
3. The references to the value function ranking a state's n-ary tree design have been clarified and made more explicit, and other clarifications were made to help tie the elements together.

The dependency of claim 34 has been changed from 33 to 53 because claim 34 provides an additional limitation on the interior-node-size estimate of claim 53.

Claim 38 has been cancelled because its limitation has been combined into claims 33, 39, and 43.

Claim 53 has been added, which provides limitations on the problem-space representation and on the value function of claim 33.

The foregoing amendments are taken in the interest of expediting prosecution and there is no intention of surrendering any range of equivalents to which Applicant would otherwise be entitled in view of the prior art.

By amending the application, the Applicant does not concede that the patent coverage available to them would not extend as far as the original claim. Rather, Applicant reserves the right to file a continuation application to pursue the breadth of the claims as filed. Applicant believes that the Examiner has not made a sufficient showing of inherency of the teachings of the asserted prior art, especially given the lack of teachings in the cited references of the properties that Applicant has recited in his claims.

Further, by the present amendment, it does not follow that the amended claims have become so perfect in their description that no one could devise an equivalent. After amendment, as before, limitations in the ability to describe the present invention in language in the patent claims naturally prevent the Applicant from capturing every nuance of the invention or describing with complete precision the range of its novelty or every possible equivalent. See, *Festo Corp. v. Shoketsu Kinzoku Kogyo Kabushiki Co.*, 62 USPQ2d 1705 (2002). Accordingly, the foregoing amendments are made specifically in the interest of expediting prosecution and there is no intention of surrendering any range of equivalents to which Applicant would otherwise be entitled.

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Article III. Conclusion

The applicant has rewritten the claims as indicated by the examiner. Applicant believes the claims are now in condition for allowance, and requests a telephone interview with the examiner if the examiner does not agree. Please reconsider this application.

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Date

Respectfully submitted,


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